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In re Application of : DECISION ON
OKUBO et al. :
Serial No.: 10/550,153 :
PCT No.: PCT/JP04/03934 : PETITION UNDER
Int. Filing Date: 23 March 2004 :
Priority Date: 25 March 2003 :
Attorney's Docket No.: 38915.00045 : 37 CFR 1.10(c)
For: METHOD OF ANALYZING ELECTROLYIC :
COPPER PLATING SOLUTION AND :
ANALYZING DEVICE...

This decision is in response to applicant's "Request for Corrected Filing Receipt" treated as a Petition under 37 CFR 1.10(c) to correct filing date, filed 22 May 2008, to accord a filing date of 19 May 2005 to the above-identified application papers. No petition fee is required.

BACKGROUND

Applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee. These papers were accorded a filing date of 20 September 2005.

On 12 May 2006, a Notification of Acceptance was mailed to applicant, indicating that the date of receipt of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements was 20 September 2005 and that the date of completion of all 35 U.S.C. 371 requirements was 25 September 2005.

On 08 April 2008, applicant filed a request for corrected filing receipt, treated as a petition under 37 CFR 1.10(c) requesting a corrected filing date of 19 September 2005, which included a copy of the Customer Receipt of the "Express Mail" mailing label #EV700301509US.

DISCUSSION

A review of the application file reveals that applicant filed a transmittal letter for entry into the national stage. No indication of the Express Mail #EV700301509US appears therein. A review of the USPTO finance records for this application indicates that the basic national fee was

paid.

37 CFR 1.10(c) states:

Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

- (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;
- (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and
- (3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

Applicant requests that the national stage papers be accorded a filing date of 19 September 2005. A review of the Express Mail label #EV700301509US reveals that it was addressed to the "Mail Stop PCT, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450". The Customer Copy of the Express Mail label bears a USPS barrel stamp of "SEP 19 2005" and a "Date-In" of "9/19/05".

However, this is insufficient evidence to establish with reasonable certainty that the national stage papers were deposited with the United States Postal Service as an "Express Mail" Mailing on 19 September 2005. Specifically, the number of the "Express Mail" mailing label does not appear to have been placed on any paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail. Since there is no indication of the "Express Mail" label number appearing on the Transmittal Letter or any other correspondence which ties the "Express Mail" label and the papers together, it cannot be concluded that the national stage papers were deposited on 19 September 2005. The requirements of 37 CFR 1.10(c) are not satisfied and the filing date of the National stage papers remain the date the papers were received or 20 September 2005.

The filing date of the application is the international filing date, 23 March 2005. The 35 U.S.C. 371 date is the date that all of the requirements of 35 U.S.C. 371(c) are completed. See MPEP §1893.03(b) regarding The Filing Date of a U.S. National Stage Application.¹

¹ An international application designating the U.S. has two stages (international and national) with the filing date being the same in both stages. Often the date of entry into the national stage is confused with the filing date. *It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application.* Specifically, 35 U.S.C. 363 provides that "An international application designating the United States shall have the effect, from its international filing date under Article 11 of the treaty, of a national

Moreover, a review of the application file reveals that the declaration is unacceptable. The given name of the applicant as listed on the published international application is "Yuka MIZUNO." The declaration, filed on 19 September 2005, identifies and is signed by "Yuka YAMADA". The executed declaration is not in compliance with 37 CFR 1.497(a) and (b) as the declaration does not name the same inventive entity as identified in the published international application. Thus, the declaration does not satisfy the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States.

It does not appear that applicant filed a request pursuant to PCT Rule 92bis to change the name of the inventor as no Notification of the Recording of a Change (Form PCT/IB/306) has been submitted which indicates that the name change was accepted. The declaration of inventors submitted by applicants on 19 September 2005 is not in compliance with 37 CFR 1.497(a) and (b) and is unacceptable. A new declaration, identifying all inventors and their citizenship, residency and mailing addresses is required. Should applicant wish to correct the third inventor's name to Yuka Yamada, a petition under 37 CFR 1.182 is required. See MPEP §605.04(c).

CONCLUSION

Applicant's petition requesting that the national stage papers be accorded a receipt date of 19 September 2005 is **DISMISSED WITHOUT PREJUDICE**.

The 12 May 2006 Notification of Acceptance is hereby **VACATED**.

For the reasons, set forth above, the declaration of inventors submitted by applicants on 19 September 2005 is not in compliance with 37 CFR 1.497(a) and (b) and is unacceptable. A new

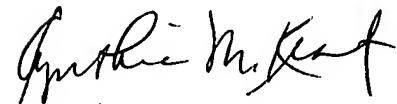
application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title." PCT Article 11(3) provides that "...an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State". 37 CFR 1.496(a), first sentence, reads "International applications which have complied with the requirements of 35 U.S.C. 371(c) will be taken up for action based on the date onwhich such requirements were met." Thus, when the file wrapper label or PALM bib-data sheet and filing receipt are printed, the information is read from the PALM data base and the information printed in the filing date box is the date of receipt of 35 U.S.C. 371(c)(1),(c)(2) and (c)(4) requirements rather than the actual international filing date. The NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) indicates the date of receipt of the 35 U.S.C. 371(c)(1), (c)(2),and (c)(4) requirements, and it also indicates the date of completion of all 35 U.S.C. 371 requirements, which is further explained below. Filing receipts are mailed concurrently with the mailing of the Form PCT/DO/EO/903. The "Application Filing Date" field formerly displayed in PAIR was changed to "Filing or 371(c) Date" to clearly indicate that for international applications that enter the national stage under 35 U.S.C. 371, the information displayed in this field is the date of receipt of the 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements. Applicants are quite often confused as to the true filing date and will ask for corrected filing receipts thinking that the information thereon is wrong. This explanation should offer some clarity. For most legal purposes, the filing date is the PCT international filing date.

declaration is required or in the alternative, a petition under 37 CFR 1.182 is required to correct the third inventor's name to Yuka YAMADA.

The application will be held in the PCT Legal Office to await applicant's further reply.

Applicant must respond within ONE (1) MONTH from the mail date of this decision.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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